

REMARKS:

Claims 1-3 and 5-20 are pending in the present application.

In the Office Action dated April 16, 2003, the Examiner first objected to certain informalities in the drawings, specifically that the "jeweled surface" recited in claim 4 was not shown in the drawings. Claim 4 has therefore been cancelled.

The Examiner also objected that the specification did not provide proper antecedent basis for the term "molded plastic" as recited in claim 10. Claim 10 has been appropriately amended to delete the word "molded."

Claims 3, 7-9, 11, 12, 14-16, 18 and 20 were rejected pursuant to 35 U.S.C. § 112 as being indefinite. Addressing each of the rejected claims:

- Claim 3 has been amended to depend from claim 1 and to positively recite that the combination ring and object holder further comprises "a lollipop having a stick, the stick of said lollipop being received and retained in an opening defined by said coupling member."
- In claim 1, "a lower distal end" of the spring is introduced in line 3 of the claim. Therefore, there is a proper antecedent basis for "the lower distal end of said spring" as recited in claims 7-9, 11 and 12.
- In claim 17, "a lower distal end" of the spring is introduced in line 4 of the claim. Therefore, there is a proper antecedent basis for "the lower distal end of said spring" as recited in claim 18.
- Claim 14 has been amended to correct a typographical error, replacing the word "substantively" with the word "substantially" in line 2 of the claim. (Similar amendments

to correct identical typographical errors were also made in claims 7, 11-12 and 17-18.)

Therefore, there is now a proper antecedent basis for "the substantially flat upper surface" as set forth in line 5 of claim 14.

- Claim 16 has been amended to depend from claim 14 and to positively recite that the combination ring and object holder further comprises "a lollipop having a stick, the stick of said lollipop being received and retained in an opening defined by said coupling member."
- Claim 20 has been amended to positively recite that the combination ring and object holder further comprises "a lollipop having a stick, the stick of said lollipop being received and retained in an opening defined by said coupling member."

The Examiner also provisionally rejected claims 1-20 of the pending application under the judicially created doctrine of obviousness-type double patenting in view of co-pending U.S. Application Serial No. 10/074,568. An initial Office Action with respect to '568 Application was issued on October 24, 2002. Since Applicant chose not to respond to that initial Office Action, the application was abandoned as of April 24, 2003. Therefore, Applicant respectfully requests that the provisional rejection be withdrawn.

Turning now to the substantive rejections of the claims, the Examiner rejected claims 1-3, 5, 7, 8, 10, 11, 14-17, 19 and 20 as being anticipated by U.S. Patent No. 6,077,144 issued to Fishman, pursuant to 35 U.S.C. § 102(b). Furthermore, claims 4, 9 and 13 were rejected as being obvious in view of the '144 Patent, pursuant to 35 U.S.C. § 103(a).

To better present his argument against this obviousness rejection, Applicant believes it to be beneficial to review the structure and features of the present invention. The present invention

is a combination ring and object holder with an integral spring that is designed to secure and retain an object, such as a lollipop. The ring is designed to be worn on the finger of an individual (i.e., a child) and has a substantially flat upper surface to which a spring is secured. A coupling member is then secured to the opposite end of the spring for receiving and retaining the lollipop or similar object, resulting in a novelty item that has great appeal to children.

The cited prior art reference, U.S. Patent No. 6,077,144, describes and claims another novelty item, a "Lollipop Holder with Random Display." Specifically, the holder is designed to hold a lollipop and to display a message in response to movement of that lollipop. In reviewing this prior art reference, the Examiner correctly notes that the device includes a holder 34 (i.e., a coupling member) for retaining and receiving a lollipop stick. A spring 38 is also described, but this internal spring 38 is used, in conjunction with a post 36, to urge the holder 34 into coaxial alignment with an aperture 24. Column 2; lines 36-38. More importantly, it is the post 36 that "is captured by an upper end 50 of the spring 38..." Column 2; line 59-60. In other words, the holder 34 is not secured to the spring 38.

Furthermore, the Examiner also points out that a ring is described in the '144 Patent, namely a spring mount 42 (which is also referred to as a mounting plate in the '144 Patent). This spring mount 42 is an internal member that may be integrally formed with the housing 16. Column 2; lines 40-42. Due to its function and positioning within the described lollipop holder, this spring mount 42 may have an annular shape, but it is clearly not the type of "ring" contemplated and described in the present application.

Referring specifically to the independent claims of the present application, namely claims 1, 14 and 17, the combination ring and object holder comprises at least the following key

elements: (1) a ring adapted to be worn by an individual; (2) a spring secured at a lower distal end thereof to said ring; and (3) a coupling member adapted to receive and retain an object and secured to an upper distal end of said spring.

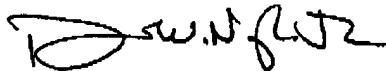
This claimed invention is simply not anticipated by the '144 Patent. It is well-settled that for an §102 rejection to stand, the cited prior art reference must disclose each and every limitation found in a claim against which it is cited because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdall Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

In this case, even if it is an annular member, the spring mount 42 of the '144 Patent is clearly not the type of ring contemplated by the claims of the present application, specifically "a small circular band...worn on the finger." See The American Heritage® Dictionary of the English Language, Fourth Edition (Houghton Mifflin Company 2000). Supporting this definition of a ring, each of the claims specifically recite that the ring is adapted to be worn by an individual. However, as an internal component, an individual can not even access the spring mount 42 described in the '144 Patent, much less wear it. Furthermore, since the spring 38 of the '144 Patent is described as a biasing means, it is not secured to an upper distal end of said spring as required the claims of the present application. In short, since the '144 Patent fails to teach or suggest critical limitations of claims 1, 14 and 17, it does not anticipate claims 1, 14, and 17 of the present application

All remaining claims of the application depend from either claims 1, 14 or 17 and are each believed to be allowable in light of the argument set forth above.

In light of the foregoing amendments and remarks, Applicant respectfully requests allowance of all claims now pending in this Application.

Respectfully submitted,



David W. Nagle, Jr., Reg. No. 42,923
STITES & HARBISON, PLLC
400 W. Market Street
Louisville, Kentucky 40202-3352
Phone (502) 587-3400
Facsimile (502) 587-6391